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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,437	12/29/2000	Warren T. Dent	MSI-423USC1	8758

22801 7590 03/04/2005

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EXAMINER

DASS, HARISH T

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,437

Applicant(s)

DENT ET AL.

Examiner

Harish T Dass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25, 27-30, 33-48, 52-53 and 55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25, 27-30, 33-48, 52, 53 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 26 & 49 are canceled.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 1-8, 12-14, 27-30, 33-38 & 55 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Starr (US 6,606,606) in view of Thomson et al (hereinafter Thomson – US 5,121,945).

Re. Claim 1, Starr discloses plurality of computing devices, coupled to the network, to facilitate network access by one or more participants, and a data server, coupled to the data network and responsive to one or more of the plurality of computing devices, the data server including [see entire document particularly, Abstract; Figures 1-2; C1 L15 to C3 L31; C4 L7-57], and a storage medium to store at least one financial account for each of the plurality of participants, and a financial transaction manager, coupled to the storage medium and selectively invoked by a participant, to manage access to and manipulation of financial account assets to effect requested financial transactions with any network participant or non-participant [C5 L57 to C6 L11]. Starr does not explicitly disclose wherein the financial transaction manager is also to issue an instruction to have a check issued that includes an offer to receive future funds via an electronic financial account, wherein the financial transaction manager is also to issue an

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instruction to have a check issued that includes an offer to receive future funds via an electronic financial account. However, Thomson discloses this feature as alternative method (SMARTCHECK) [Abstract; Figure 1; C6 L53; C7 L60-L65] to allow payer to select an alternative method of payment, which is advertised on the detachable bill stub. Further, URL are well known, which allow the Internet user to surf web pages of web sites such as banks, universities, brokerage firms, etc. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Starr and include an offer advertisement, as discloses by Thomson to select an enrollment for EFT by using URL for accessing on line services though the Internet.

Re. Claims 2-7 Starr discloses wherein the financial account is electronically linked to an account of the participant at a financial institution, and wherein the account of the participant is one of a checking account, a savings account, a line of credit, and a money market account maintained by a banking institution, or a services account associated with another commercial enterprise, and wherein the financial account is one of a checking account, a savings account, a line of credit, and a money market account maintained by a banking institution, and further comprising a financial service center having a plurality of data servers including the data server, and wherein the data server is controlled by a financial institution [C1 L15 to C3 L31; C5 L57 to C7 L4], and enabling the customer to access to financial account using PC [C4 L57 to C5 L57]. Starr, explicitly, does not disclose access financial account using a kiosk, a telephone and a set-top box. However, Thomson discloses ATM (a kiosk) as an alternative payment

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method [C18 L22-L37] for payment settlement. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Starr and include access to financial institutions system using ATM, as described by Thomson, to allow user to use widely available ATM for payment settlement.

Re. Claim 8, Starr discloses wherein the financial transaction manager selectively transfers assets from a first participant's account to a second participant's account in response to a request by the first participant to transfer such assets [C1 L15 to C3 L5].

Re. Claims 12-14 Starr discloses wherein the financial transaction manager selectively receives assets for deposit in an account of a participant, and wherein the assets are received from a brokerage at the request of the participant, and wherein the assets are received from an employer as compensation to the participant [C1 L15 to C3 L31; C6 L12-L52].

Re. Claim 27, Starr discloses a user interface, through which a user accesses an account associated with the user, one or more storage devices, to store and maintain account information for each of the users, and a financial transaction manager, responsive to the user interface and coupled to the one or more storage devices, to manage access to and control assets of user accounts in response to user interaction with the user interface to enable the user to conduct financial transactions with another

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user or non-user of the financial service center, wherein the financial transaction manager causes a check to be printed and sent to another at the request of a user [Abs; Fig1-2; C1 L15 to C3 L31; C4 L7-57; C5 L57 to C6 L11]. Starr does not explicitly disclose wherein the check includes an offer to receive future funds via an electronic account at the financial service center. However, Thomson discloses this feature as alternative method (SMARTCHECK) [Abstract; Figure 1; C6 L53; C7 L60-L65] to allow payer to select an alternative method of payment, which is advertised on the detachable bill stub. Further, URL are well known, which allow the Internet user to surf web pages of web sites such as banks, universities, brokerage firms, etc. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Starr and include an offer advertisement, as discloses by Thomson to select an enrollment for EFT by using URL for accessing on line services though the Internet.

Re. Claims 28-30 & 33-35, Starr discloses a user interface web page (wherein the user interface is series of instructions issued to a computing device of the user to create a web page at the computing device) [C4 L25-L48], an email (wherein the user interface is a series of instructions issued to an email client executing on a computing device of the participant) [C8 L37 to C9 L19], and wherein the financial transaction manager selectively transfers assets from a first user's account to a second user's account in response to a request by the first user to transfer such assets [C1 L15 to C3 L5], and wherein each of the first and second users are individual consumers, and wherein the

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first user does not have a priori knowledge of the second user's account information, but identifies the second participant from a list of network participants provided by the financial transaction manager, and wherein the second user is identified by one or more of the user's name, alias, or email address [Fig. 3-4; C1 L15 to C3 L5; C7 L5-L20; C8 L37 to C9 L19].

Re. Claims 36-38 Starr discloses wherein the financial transaction manager selectively receives assets for deposit in an account of a participant, and wherein the assets are received from a brokerage at the request of the participant, and wherein the assets are received from an employer as compensation to the participant [C1 L15 to C3 L31; C6 L12-L52].

Re. Claim 55, Starr discloses a storage device having stored thereon a plurality of executable instructions, and a processor, coupled to the storage device, to execute the instructions and implement a financial transaction manager, wherein the financial transaction manager enables a user to conduct financial transactions with a number of people [Abs; Fig1-2; C1 L15 to C3 L31; C4 L7-57; C5 L57 to C6 L11]. Starr does not explicitly disclose wherein each of the checks includes an offer to receive future funds via an electronic financial account. However, Thomson discloses this feature as alternative method (SMARTCHECK) [Abstract; Figure 1; C6 L53; C7 L60-L65] to allow payer to select an alternative method of payment, which is advertised on the detachable bill stab. Further, URL are well known, which allow the Internet user to surf web pages of web sites such as banks, universities, brokerage firms, etc. It would have been

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obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Starr and include an offer advertisement, as discloses by Thomson to select an enrollment for EFT by using URL for accessing on line services though the Internet.

Claims 9-11 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Starr and Thomson, as applied to claim 1 above, and further in view of Schrader et al (hereinafter Schrader – US 5,903,881).

Re. Claims 9-11 Starr or Thomson does not explicitly disclose wherein each of the first and second participants are individual consumers, and wherein the first participant does not have a priori knowledge of the second participant's account information, but identifies the second participant from a list of network participants, and wherein the second participant is identified by one or more of a name, an alias, a physical address, a virtual address, or an email address. However, Schrader discloses these steps [see entire document particularly, Abs; Fig. 3-11; C1 L5 to C7 L14]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosure of Starr, Thomson and Schrader to provide customer (individual user) an online banking system to manage its account.

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Claims 15-22, 39-45, and 52-53 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Starr and Thomson, as applied to claims 1 & 27 above, and further in view of O'Leary et al (hereinafter O'Leary – US 6,609,113).

Re. Claim 15-17 Starr or Thomson does not explicitly disclose wherein the financial transaction manager prompts a participant for payment authorization in response to a request for payment received from a network service, and wherein the network service is an electronic auction service, and wherein the network service is an electronic retail service. However, O'Leary discloses these steps [C15 L45 to C16 L55; C20 L44 to C21 L44]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to disclosures of Starr, Thomson and O'Leary to allow user to purchase items or a service through an electronic auction or other convenient e-commerce locations (retail service).

Re. Claims 18-22, Starr or Thomson does not explicitly disclose wherein the financial transaction manager transfers assets from an account specified by the user to an account specified in the request to cover the requested payment, upon authorization of the participant, and wherein the financial transaction manager determines whether to honor the participants payment when the specified account has insufficient assets to cover the requested payment, and wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment, and wherein the

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financial transaction manager automatically accesses a line of credit associated with the participant to honor the payment when the specified account has insufficient assets to cover the requested payment, and wherein the financial transaction manager notifies the participant of the insufficient funds and that the line of credit has been accessed to honor the requested payment. However, O'Leary discloses these steps [C16 L17 to C17 L32]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures of Starr, Thomson and O'Leary to verify the user's balance in the primary account is sufficient to make payments or make overdraft or use line-of-credit.

Re. Claims 39-41 Starr or Thomson does not explicitly disclose wherein the financial transaction manager prompts a participant for payment authorization in response to a request for payment received from a network service, and wherein the network service is an electronic auction service, and wherein the network service is an electronic retail service. However, O'Leary discloses these steps [O'Leary et al C15 L45 to C16 L55; C20 L44 to C21 L44]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to disclosures of Starr, Thomson and O'Leary to allow user to purchase items or a service through an electronic auction or other convenient e-commerce locations (retail service).

Re. Claims 42-45 Starr or Thomson does not explicitly disclose wherein the financial transaction manager transfers assets from an account specified by the user to an

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account specified in the request to cover the requested payment, upon authorization of the participant, and wherein the financial transaction manager determines whether to honor the participants payment when the specified account has insufficient assets to cover the requested payment, and wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment, and wherein' the financial transaction manager automatically accesses a line of credit associated with the participant to honor the payment when the specified account has insufficient assets to cover the requested payment However, O'Leary discloses these steps [C16 L17 to C17 L32;]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures of Starr, Thomson and O'Leary to verify the user's balance in the primary account is sufficient to make payments or make overdraft or use line-of-credit.

Re. Claims 52-53 Starr or Thomson does not explicitly disclose receiving a request to issue a check to a recipient from a consumer, including on the check an offer to receive future funds via an electronic financial account with a pre-printed unique access code for the account (PIN), and receiving a request to perform a financial transaction at a data server within a financial data network from a requesting participant, and issuing a physical check drawn from an account on the financial data network associated from an account of the network participant to the transaction recipient, wherein the check includes an offer (coupon) to utilize an account created within the electronic financial

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network and associated with the requesting participant to receive future funds.

However, O'Leary discloses these steps [see entire document particularly, Abs; Figures 1-10; C1 L22 to C8 L5]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to disclosures of Starr, Thomson and O'Leary to enable user of Internet to have immediate access to financial institution account and make low cost payments.

Claims 23-25 and 46-48 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Starr, Thomson and O'Leary, as applied to claims 1 & 27 above, and further in view of Schrader.

Re. Claims 23-25, Starr, Thomson or O'Leary does not explicitly disclose wherein the instruction is an instruction to have the check issued and sent to an address specified by the request, upon authorization of the participant, wherein the issued check includes a uniform resource locator (URL) address of a web page offered by the data server where the recipient can establish an account, wherein the check includes an offer of free assets, credited to a newly established account created by the recipient of the check. However, Schrader discloses these steps [Fig. 3-11; C1 L5 to C7 L14]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures of Starr, Thomson, O'Leary and Schrader to allow the customer make a payment online using the web page URL provided to reduce cost on payment transaction.

Re. Claims 46-48, Starr, Thomson or O'Leary does not explicitly disclose wherein the instruction is an instruction to have the check issued and sent to an address specified by the request, upon authorization of the participant, and wherein the issued check includes a uniform resource locator (URL) address of a web page offered by the data server where the recipient can establish an account, and wherein the check includes an offer of free assets, credited to a newly established account created by the recipient of the check. However, Schrader discloses these steps [Fig. 3-11; C1 L5 to C7 L14]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures of Starr, Thomson, O'Leary and Schrader to allow the customer make a payment online using the web page URL provided to reduce cost on payment transaction.

Response to Arguments

2. Applicant's arguments filed 11/24/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that "where the financial transaction manager is also to issue an instruction to have a check issued that includes an offer to receive future funds via an electronic financial account", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the

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claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Prior reference Thomson et al (US 5,121,945) discloses an integrated billing document (invoice, maintenance and payment, and bank check) with the maintenance and payment selection alternative instruction [Fig 1; C7 L46 to C8 L7; C18 L22-L36]. The Thomson system is capable of enabling alternative information formats to encourage usage of different payment system by giving market incentives offered to payer [C18 L46-L54]. Therefore, It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of primary reference and include instruction(s) or solicitation(s) such as comprehensive payment alternative Smart Card (electronic fund)) or any other instruction and offers.

Regarding Applicant's comment on URL, the statement "Further URL are(is) well know" was part of motivation to use EFT using online services web page.

In response to Applicant argument regarding claims 9-11 that Schrader does not disclose steps of claims 9-11. See figures 9-10 "Create New Payment Instruction" An Individual (you a customer) wishes to pay to "company or individual" (PG&E - which can be another a customer). PG&E is alias for a company such as: Potomac Gas & Electric

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or Pennsylvania Gas & Electric and there is no account number for PG&E (billing account number is not PG&E fund transfer number).

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Sough can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass
Examiner
Art Unit 3628

3/1/05


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600